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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,110	02/13/2006	Achim Adam	710100-22	5504

7590 08/03/2007
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38525 Woodward Avenue
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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

MAIL DATE	DELIVERY MODE
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08/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/568,110	Applicant(s) ADAM ET AL.	
	Examiner John J. Zimmerman	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

SECOND OFFICE ACTION

Amendments

1. The "AMENDMENT" received May 31, 2007 has been entered. Claims 1-8 are pending in this application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the pending claims of copending U.S. Patent Application No. 10/568,109 in view of Kawachi (U.S. 2003/048961). Although the conflicting

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claims are not identical, they are not patentably distinct from each other because they claim the same composite multilayer material, having a backing layer, a bearing layer of copper alloy or aluminum alloy, a nickel intermediate layer having a thickness of greater than 4 μm and an overlay layer containing 0-20 wt.% copper and/or silver. The claims differ mainly in that the overlay layer further contains bismuth in the copending application and further contains tin in the pending application. Kawachi, however, clearly shows that Sn, Pb and/or Bi alloys are considered obvious alternative alloy bases for overlay layers in the bearing art (e.g. see paragraphs [0001]-[0003]). In view of Kawachi, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any one of Sn, Pb and/or Bi base alloys for a overlay layer since these are all shown to be considered obvious alternative alloy bases for overlay layers in the bearing art. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huhn (U.S. 2001/0016267).

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6. Huhn discloses a bearing having a backing layer, a lead-bronze bearing layer, a nickel intermediate layer, a further nickel-tin layer and an overlay (e.g. see claim 1). The backing layer can be steel (e.g. see paragraph [0037]). The first nickel intermediate layer has a thickness of between 1 to 4 μm (e.g. see paragraph [0030]) and the nickel-tin second intermediate layer has a thickness of between 2 and 7 μm (e.g. see paragraph [0029]) and the overlay can have a thickness of 5 to 25 μm (e.g. see paragraph [0028])). The bearing alloy can be copper-aluminum, copper-tin, copper-tin-lead, etc. . . (e.g. see paragraph [0030]). The bearing is exposed to elevated temperatures that would inherently cause some interdiffusion between the layers (e.g. see paragraph [0047]). Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. The overlay of Huhn is a tin based alloy that contains 5 to 48 % of tin-copper particles (e.g. see paragraphs [0019] and [0023]). While the overall copper range in the tin based overlay of Huhn may not be coextensive with the claimed range, the subject matter as a whole would have been obvious to one having ordinary

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skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549. Likewise, while the thickness range of the overlay of Huhn may not be coextensive with all the claimed overlay thickness ranges, the ranges overlap and it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to practice the thickness ranges of Huhn over his entire disclosed range. In addition, while the thickness range of the nickel first intermediate layer of Huhn may be 1 to 4 μm and the applicant claims a thickness range of "greater than 4 μm ", the values of "4 μm " and "greater than 4 μm " are so close that *prima facie* one of ordinary skill in the art would not expect them to be patentably distinct. A review of the applicant's disclosure shows no factual data patentably distinguishing a nickel layer thickness value of "4 μm " from "greater than 4 μm ". In any event, the nickel-tin second intermediate layer of Huhn clearly falls in the applicant's claimed range.

Response to Arguments

7. Applicant's arguments filed May 31, 2007 have been fully considered but they are not persuasive with regards to the remaining rejections.

8. A terminal disclaimer over copending U.S. Patent Application No. 10/568,109 was received on May 31, 2007. The terminal disclaimer, however, was not approved because the attorney or agent is not of record in this application. Therefore, the provisional non-statutory obviousness-type double patenting rejection has been maintained.

9. Regarding the rejection under 35 U.S.C. 103(a) as being unpatentable over Huhn (U.S. 2001/0016267), Huhn discloses a bearing having a backing layer, a lead-bronze bearing layer, a nickel intermediate layer, a further nickel-tin layer and an overlay (e.g. see claim 1). The backing layer can be steel (e.g. see paragraph [0037]). The first nickel intermediate layer has a thickness of between 1 to 4 μm (e.g. see paragraph [0030]) and the nickel-tin second intermediate layer has a thickness of between 2 and 7 μm (e.g. see paragraph [0029]) and the overlay can have a thickness of 5 to 25 μm (e.g. see paragraph [0028])). The overlay of Huhn is a tin based alloy that contains 5 to 48 % of tin-copper particles (e.g. see paragraphs [0019] and [0023])). As noted in the rejection, above, while the overall copper range in the tin based overlay of Huhn may not be coextensive with the claimed copper range of about 0-20 wt.%, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549. Applicant argues that the thickness range of the nickel first intermediate layer of Huhn is a thickness capable of being no greater than 4 μm , unlike applicant's claimed thickness range of greater than 4 μm . As noted in the rejection, however, the values of "4 μm " and "greater than 4 μm " are so close that *prima facie* one of ordinary skill in the art would not expect them to be patentably distinct and a review of the applicant's disclosure shows no factual data patentably distinguishing a nickel layer thickness value of "4 μm " from a value of "greater than 4 μm ". In any event, the nickel-tin second intermediate layer of Huhn

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clearly falls in the applicant's claimed range and there is no requirement in the claim that the nickel layer must consist of nickel.

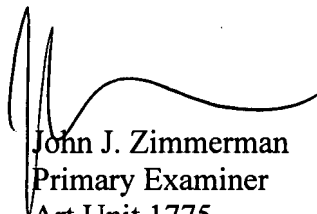
Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
July 30, 2007